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09/935,318	08/22/2001	David Dale Ricke	CHA920010008US2	1462
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HOFFMAN WARNICK & D'ALESSANDRO, LLC			EXAMINER	
75 STATE STREET			KENDALL, CHUCK O	
14TH FL			ART UNIT	
ALBANY, NY 12207			PAPER NUMBER	
			2192	
DATE MAILED: 10/11/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/935,318

Applicant(s)

RICKE, DAVID DALE

Examiner

Chuck O. Kendall

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, & 5 - 29 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, & 5 - 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

RD

**DETAILED ACTION**

1. This action is in response to the application filed 07/19/05.
2. Claims 1 – 3, & 5 – 29 have been examined.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The invention as disclosed in claims 1 – 3, 7 – 10, 13 – 15, & 23 – 29 is directed to non-statutory subject matter.

4. Claims 1 – 3, 7 – 10, 13 – 15, & 23 – 29, are not even claimed to be practiced on a computer, therefore, it is clear that the claims are limited to practice in the technological arts. On that basis alone, they are clearly nonstatutory.

5. Regardless of whether any of the claims are in the technological arts, none of them is listed to practical applications in the technological arts. Examiner finds that *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994) controls the 35 U.S.C. 101 issues on that point for reasons made clear by Federal Circuit in *AT&T Corp. v. Excel Communications, Inc.*, 50 USPQ2d 1447 (Fed. Cir. 1999). Specifically, the Federal Circuit held that the act of:

*Taking several abstract ideas and manipulating them together adds nothing to the basic equation.*

*AT&T v. Excel at 1453 quoting In re Warmerdam, 33 F.3d 1354, 1360 (Fed. Cir. 1994).*

Examiner finds that Applicant's "Knowledge base" references are just abstract ideas. Further more Examiner deems Applicant's references to Knowledge base. This is noted in a direct exert from the MPEP, which states:

" "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) as nonfunctional descriptive material".

Applicant's claims to the Knowledge base is merely a data structure per se and hence is categorized as a nonfunctional descriptive material.

Claims 1 – 29 also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 – 3, 5 – 10, 13, 19, 21 & 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douik et al. USPN 6,012,152 (art of record) in view of Kohn et al. USPN 5,963,447 (art being made of record).

Regarding claim 1, Douik discloses a framework for providing information technology solutions, the framework comprising:

a first knowledge base of characteristics that describe products and functions, wherein a combination of products performs a set of functions (20: 45 – 50, see I-MIB 36);

a second knowledge base that manages relationship information regarding the interactions of products and defines all valid product combinations, wherein each valid product combination forms a network unit (23:48 –52, see MIB 37); and

a third knowledge base that manages information regarding the interconnectability of network units, wherein a valid combination of network units comprises a configuration (20:52 – 57, see knowledge base 38 and model 39).

Although, Douik doesn't explicitly disclose a fourth knowledge base wherein each cloud describes a set of possible configurations that can fulfill a predetermined function, Douik does disclose in 21:20 – 27, a model description and corresponding graphical representation. Kohn, discloses in an analogous a knowledge base system which supports configuration and incremental change of scenerios (possible combinations) 8:65 – 9:15.

Therefore it would have been obvious to one of ordinary skills in the art at the time the invention was made to combine Douik and Kohn because, it would enable architectures "to have built-in flexibility incrementally improve on fixed architectures" (9:20 – 23).

Regarding claim 2, the framework of claim 1, wherein the first knowledge base of characteristics includes generic characteristics that describe a set of products or functions having similar characteristics (Douik, 25:60-65).

Regarding claim 3, the framework of claim 1, wherein the second knowledge base includes generic network units that describe a set of network units that perform similar functions (Doiuk, 17: 50 –67, see managed objects sharing same attributes, behavior, etc).

Regarding claim 5, the framework of claim 1, wherein each configuration comprises at least one network unit partnership (Douik, 21:22 – 26, see telecommunication and MTA, which is understood be a networked system of subscribers).

Regarding claim 6, the framework of claim 1, further comprising a key word search engine that allows characteristics to be searched (Douik, 16:65 –67).

Regarding claim 7, the framework of claim 1, further comprising a solution knowledge base, wherein each solution includes a set of customer specific configurations (Douik, 28: 24 – 30, see technical solution, troubleshooting and description).

Regarding claim 8, the framework of claim 7, further comprising a box knowledge base that includes a product listing for each solution in the solution knowledge base (Douik, 28: 24 – 30, see suspected products and the products).

Regarding claim 9, the framework of claim 8, further comprising a network knowledge base that includes a set of boxes (Douik, 28:10 – 13, see dialogue boxes).

Regarding claim 10, the framework of claim 9, further comprising a customer knowledge base that includes customer specific information (Douik, 9: 20 – 25, see customer trouble reports).

Regarding claim 13, which recites similarly as claim 1, which depends on claim 1, see reasoning above as previously discussed.

Regarding claim 19, program product version of claim 13, see reasoning above as previously discussed.

Regarding claim 21, the program product of claim 19, wherein the set of characteristics include products and functions, (Douik, 18: 1 – 15).

Regarding claim 23, see reasoning in claim 1.

9. Claims 11,12,14 – 18, 20, 22 & 24 – 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douik et al. USPN 6,012,152 (art of record) in view of Kohn et al. USPN 5,963,447 (art being made of record), as applied in claim 4 in view of Brobst (art of record).

Regarding claim 11, Douik as modified discloses all the claimed limitations as applied in claims 4 above. Although, the combination of Douik and Kohn doesn't explicitly disclose a solution advisor tool for specifying the solution using a selected cloud, a system for replacing the selected first cloud with a set of clouds, a system for replacing the selected cloud with at least one configuration, a system for replacing a selected configuration with at least one network unit, and a system for replacing a generic network unit with a specific network unit, Douik does disclose in 21:20 – 27, a model description and corresponding graphical representation.

Brobst, discloses in an analogous art a cloud configuration describing the predetermined functions (FIG.5, also see associated text).

Therefore it would have been obvious to one of ordinary skills in the art at the time the invention was made to combine Douik and Kohn with Brobst because, it “permits program developers to more quickly develop and more easily maintain server programs” (Brobst, 2:20 – 23).

Regarding claims 12 & 18, Douik as modified discloses all the claimed limitations as applied in claim 11 above. Although, Douik doesn’t explicitly disclose replacing a generic characteristic with a specific characteristic, Douik does disclose a framework (14:13 – 15), which in general is made up of default/core classes and user extensible classes (customizable with specific characteristics), So Examiner interprets this limitation to be an inherent functionality for any Framework.

Regarding claim 14, the solution advisor tool of claim 13, further comprising a fifth database of keywords (Douik, 7: 33 – 40, see key issues, indexing cases episodic memory).

Regarding claim 15, the solution advisor tool of claim 13, further comprising a sixth knowledge base of valid network unit partners (Douik, 34: 17 –20).

Regarding claim 16, see claim 12 for reasoning.

Regarding claim 17, see claim 12 for reasoning.

Regarding claim 20, the program product version of claim 12, see reasoning above as previously discussed generic characteristics with specific characteristics.

Regarding claim 22, Douik as modified discloses all the claimed limitations as applied in claim 19 above, as well as storing information regarding configurations, network units and characteristics, (see Douik, 11: 65 – 12:5, for functional model of the network and for configuration also see 18: 15 – 30 for modeling and managed object definitions).

Although the combination of Douik and Kohn, doesn’t explicitly disclose a system for storing and managing information regarding the clouds, Douik does disclose in 21:20 – 27, a model description and corresponding graphical representation. Brobst,



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discloses in an analogous art a cloud configuration describing the predetermined functions (FIG.5., also see associated text).

Therefore it would have been obvious to one of ordinary skills in the art at the time the invention was made to combine Douik and Kohn with Brobst because, it “permits program developers to more quickly develop and more easily maintain server programs”. (Brobst, 2:20 – 23).

Regarding claim 24, Brobst, further discloses the solution advisor tool of claim 23, wherein the cloud knowledge base includes business need clouds that contain application cloud network units and application gateway network units (Brobst, FIG. 5, see REMOTE cloud).

Regarding claim 25, the solution advisor tool of claim 23, wherein the cloud knowledge base includes application clouds that contain transport cloud network units and transport gateway network units (Brobst, see SmManagementService Object cloud).

Regarding claim 26, the solution advisor tool of claim 23, wherein the cloud knowledge base includes transport clouds that contain bridged cloud network units, subnetwork cloud network units and subnetwork gateway network units (see Brobst, FIG. 5, SmServerImpl cloud).

Regarding claim 27, the solution advisor tool of claim 23, wherein the cloud knowledge base includes bridged clouds that contain subnetwork cloud network units and subnetwork gateway network units (see Brobst, FIG.5, GenericService Object, see arrows for communication flow/transport).

Regarding claim 28, the solution advisor tool of claim 23, wherein the cloud knowledge base includes subnetwork clouds which contain gateway network units (see Brobst, SmManagementService Object cloud).

Regarding claim 29, see reasoning in claim 11.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1 – 3, & 5 – 29 have been considered but are moot in view of the new ground(s) of rejection.

### **Correspondence information**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuck Kendall whose telephone number is 571-272-3698. The examiner can normally be reached on 10:00 am - 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on 571-272-3695. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ck.



**TUAN DAM**  
**SUPERVISORY PATENT EXAMINER**